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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 711

PETROCARBON LIMITED, *Petitioner*,

v.

ROBERT C. WATSON, Commissioner of Patents,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING AND PETITION FOR REHEARING

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MOTION FOR LEAVE TO FILE PETITION FOR REHEARING

Petitioner respectfully moves for leave to file the annexed petition for rehearing of the order of this Court denying the petition for writ of certioari in this case, entered March 3, 1958.

Rehearing is sought at this time because the pending petition for writ of certiorari, filed April 4, 1958, No. 896, *Frederick C. Bersworth and The Dow Chemical Company* v. *Robert C. Watson*, Commissioner of Patents, presents to the Court substantially the same issues as were presented by the petition in the present case.

Petitioner submits that the judgments of the United States Court of Appeals for the District of Columbia Circuit in both cases should be reviewed at the same

time (see, e.g., *Pickett* v. *Union Terminal Co.*, 313 U.S. 591, 314 U.S. 704, 315 U.S. 386, 394, and *Bowden* v. *Fort Smith*, 314 U.S. 651, 315 U.S. 793, 316 U.S. 584).

Although this petition for rehearing is filed after the expiration of the time prescribed in Rule 58, the grounds upon which it is based arose after such time, and the Court clearly has power, in its discretion, to entertain the petition (see, e.g., *Clark* v. *Manufacturers Trust Co.*, 335 U.S. 910, 337 U.S. 953, 338 U.S. 241, 242).

RALPH H. HUDSON
Counsel for Petitioner

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

Petitioner prays that this Court grant rehearing of its order of March 3, 1958, denying the petition for writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit, and that a writ of certiorari issue to review the judgment of the Court of Appeals as prayed for in the petition filed January 7, 1958, herein.

REASONS FOR GRANTING REHEARING AND ISSUING THE WRIT

Since the denial of the petition for writ of certiorari in the present case (No. 711) another petition for writ of certiorari has been filed (No. 896) and is now pending before the Court raising esentially the same questions.

Also in a third and later decision of a similar issue, the same Court of Appeals has reached a conclusion believed to be contrary to its conclusion in Nos. 711 and 896.

The second petition, No. 896, *Frederick C. Berseworth et al.* v. *Robert C. Watson*, Commissioner of Patents, seeks to have this Court review the judgment of the Court of Appeals for the District of Columbia Circuit in *Berseworth* v. *Watson*, Commissioner of Patents, 116 USPQ 79. In this case the Court of Appeals for the District of Columbia held for the second time, but *again by a two-to-one* decision,—

(1) that the sufficiency of the description in a patent specification

> "to enable any person skilled in the art * * * to make and use"

the invention is a matter of law, to be determined from the face of the specification; and

(2) that the testimony of a "person skilled in the art" was not admissible, in an action under 35 U.S.C. 145, to prove facts which rebut conclusions of Patent Office officials as to the significance of the description to "persons skilled in the art".

The first clear-cut decision of these questions by the Court of Appeals was in the present case (No. 711), in which Judge Burger dissented. This Court refused to grant certiorari.

Now essentially the same questions are presented a second time by the petition in No. 896. Here the District Court found as a *fact*, on the basis of newly presented evidence, that the description *did* meet the requirements of 35 U.S.C. 112. But the Court of Appeals, Judge Danaher dissenting, held that he should have reached the contrary conclusion as a matter of *law*, without regard to the facts.

The questions presented by these two cases arise almost entirely in the District of Columbia Circuit. Issued patents raising similar questions are not likely to be reviewed by other Federal Courts because patent applications not conforming to the standards of the Patent Office will presumably be refused issuance. Such refusals by the Patent Office can only be reviewed by appeal to the United States Court of Customs and Patent Appeals (35 U.S.C. 141), or in the alternative "by civil action against the Commissioner in the *United States District Court for the District of Columbia*" (35 U.S.C. 145).

But occasionally a related issue arises in an infringement suit, as in *Moist Cold Refrigerator Co.* v. *Lou*

Johnson Co., Inc., 115 USPQ 160, 167. In this case the Circuit Court of Appeals for the Ninth Circuit specifically held that

> "Whether or not a disclosure is sufficient is a question of fact. Shumacher v. Button-Lath Mfg. Co., 9 Cir., 292 F. 522, 533, (1920); Anraku v. General Electric Co., 9 Cir., 80 F.2d 958, 963, 28 USPQ 57, 62. We cannot hold that plaintiff's evidence was insufficient, as a matter of law, as to this factual question."

The *Szwarc* case (the subject of this Request for Rehearing in No. 711) and the *Borsworth* case (the subject of the Petition for writ of certiorari in No. 896) are inconsistent with the subsequent decision of the Court of Appeals for the District of Columbia in *Interchemical Corporation* v. *Watson*, 251 F.2d 390, which presented a similar issue of the propriety of receiving testimony explanatory of the meaning of the disclosure and claims. In this case, the Court of Appeals held that

> "The question is obviously one that the trier of the facts must determine from the testimony of experts."

As is evident, the Court of Appeals ruled that the District Court was not controlled by the presumption of correctness which attaches to the Patent Office action but was free to reach its own conclusions on the basis of evidence not presented before the Patent Office. This is the situation involved here. Simply phrased, the question presented is whether it is proper and incumbent upon the District Court to consider evidence which was not presented before the Patent Office.

In the Szwarc case, Judges Bazelon, Washington and Burger participated. Judges Bazelon and Washington held that it was proper for the District Court to refuse to consider new evidence; whereas, Judge Burger dissented stating that the District Court should have permitted appellant an opportunity to make good on his offer of proof and then evaluate the testimony before deciding the case. In the Bersworth case, Judges Edgerton, Bazelon and Danaher participated. Judges Edgerton and Bazelon held that it was improper for the District Court to consider new evidence while Judge Danaher dissented in a vigorous and lengthy dissent. In the most recent Interchemical case, Judges Prettyman, Miller and Bazelon joined in a per curiam opinion that the testimony of experts is proper.

The above cases clearly show that in the limited jurisdiction within which actions under 35 U.S.C. 145 may be brought, there is a decided conflict of opinion among the seven judges participating. Four judges have held that the question is one of fact, two judges that it is a question of law. Judge Bazelon, who sat in all three cases, voted twice for the question of law but in the Interchemical case voted for the question of fact.

Thus it appears that the decisions of the Court of Appeals in Nos. 711 and 896 are out of line and not in accordance with the majority of the seven judges of the Court of Appeals for the District of Columbia Circuit who have considered these questions, as well as with the recent decision of the Court of Appeals for the Ninth Circuit. It is incumbent upon the Supreme Court to review these cases in the interest of justice and judicial consistency.

These questions continue to be of fundamental and practical importance with regard to inventors both in the United States and abroad. As Judge Danaher said in the Bersworth case:

> "The philosophy permeating the majority opinion basically is one of nullification of the remedy provided by Congress, a result here reached (1) by according to the Patent Office the equivalent of a conclusive presumption of correctness; and (2) by holding that sufficiency of disclosure raises a question of law."

Only review by this Court can resolve this conflict of opinion and settle the interpretation of 35 U.S.C. 112.

Petitioner submits that the petition in No. 896 should be granted and that if it is granted, the judgments in both Nos. 711 and 896 should be reviewed at the same time.

CONCLUSION

For the reasons set forth above and in the petition for writ of certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Appeals for the District of Columbia Circuit.

Respectfully submitted,

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Certificate of Counsel

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay, and is restricted to grounds specified in Rule 58(2) of the rules of this Court.

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